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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: (

Gregory R. FURNISH et al.)

Confirmation No.: 8531

Application No.: 10/774,330)

Group Art Unit: 3732

Filed: February 6, 2004)

Examiner: Hao D. Mai

Title: BALL AND SOCKET CORONARY STABILIZER

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

By Official Action dated August 22, 2007, restriction to one of the following inventions is required under 35 U.S.C. § 121:

“Species I”: Figure 5 (claims 28-36)

“Species II”: Figure 6 (claims 37-44)

“Species III”: Figure 7 (claims 28-34)

Claims 27, and 45-49 are stated in the Office Action to be generic.

In response, Applicants hereby provisionally elect with traverse the “Species I” set forth above as identified by the examiner in said Official Action. As a result, Applicants believe at least current pending claims 27-36 and 45-49 read upon said elected species.

The election is made with traverse, because of the similarity of subject matter being claimed puts no serious burden on the Examiner to search and examine all of the claims in the entire application. The Examiner is reminded that the Examiner must search and examine the entire application on its merits even if it includes claims to independent or distinct inventions if the search puts no serious burden on the Examiner. M.P.E.P. § 803.

In view of the similar subject matter of the claims and the powerful electronic search tools available to the Examiner, Applicants assert that searching and examination of the entire application would not pose a serious burden on the Examiner. Applicants remind the Examiner that some explanation must be given as to why there would be a serious burden on the Examiner if restriction is not required. Under MPEP § 808.02, the Examiner must show by appropriate explanation one of the following:

- (A) Separate classification; or
- (B) A separate status in the art when they are classifiable together; or
- (C) A different field of search.

With regard to point (A), Applicants contend that each of the disclosed species reasonably falls under the same or very similar classifications. Furthermore, Applicants believe that the species have not attained recognition in the art as separate subjects for inventive effort, necessitating a separate field of search. If the Examiner believes otherwise, Applicants' respectfully request that the separate classifications of the species be made of record.

With regard to point (B), even if the species are classified together, Applicants contend that the species do not form a separate subject for inventive effort, nor do they constitute a separate status in the art. All of the species claim a stabilizing device for a surgical procedure, involving a rotatable and pivotable bifurcated member with a form of a ball and socket connecting means. The different species do not form a separate subject or have a separate status in the art, as commonly understood by a person with skill in the art. If the Examiner believes otherwise, Applicants request that an appropriate explanation be made of record.

With regard to point (C), Applicants sincerely believe that it is not necessary to search for one of the species in a manner that is not likely to result in finding art pertinent to the other species, e.g., by searching different classes/subclasses or electronic resources, or employing different search queries, even if the two species are classified together. Due to the similarity of

the subject matter of the species as discussed above, a different field of search should not be required. If the Examiner believes otherwise, Applicants request that an appropriate explanation be made of record, showing the different fields of search for each species.

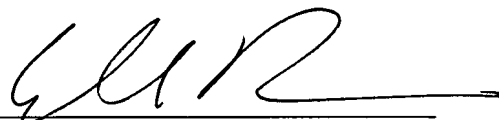
Applicants respectfully contend that for all of the species, classification is the same, and the field of search is the same. Accordingly, no reasons exist for dividing among independent or related inventions. Finally, the Applicant has paid for, by virtue of payment of the filing fees, search and examination of the pending claims. Requiring the Applicant to re-file the non-elected claims in divisional applications would require the Applicant to pay duplicative fees.

At least in view of the above, Applicants respectfully request withdrawal of the restriction requirement and examination of all pending claims. Applicants, of course, also reserve the right to file one or more divisional applications covering the subject matter of the non-elected claims.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59472.22104.

Respectfully submitted,

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